

REMARKS

Claims 1-12 were pending at the time of examination. No claims have been amended or added. The applicant has corrected some errors in the status indicators of the claims to appropriately reflect the status of the claim. In particular, the "previously presented" status indicators as noted in the response filed on December 20, 2004, should have been labeled "original," which has been corrected in this amendment. The applicant respectfully requests reconsideration based on the foregoing amendments and these remarks.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 3-5, 7-9 and 11-12 were rejected under 35 U.S.C § 102(a) as being anticipated by IBM Corporation "Parameterized XSL Style Sheets," July 1999, ref # 0374-4353-42-423-0 (hereinafter "IBM"). The applicant respectfully traverses these rejections.

Claim 1 describes a method for service side filtering of a message in a distributed network. That is, claim 1 describes a method where a message is filtered on the server where the message resides, before it is passed to a client. IBM does not disclose this notion. Rather, IBM merely discloses parameterized XSL style sheets that are used in a text transformation engine, in order to convert an XML document from one document object model to another (IBM, page 1, lines 30-40). The purpose of the IBM conversion is to achieve a document format that is more closely suited for the recipient and thereby to accommodate for the recipient's limitations and preferences (IBM, page 1, lines 1-8). It is respectfully noted that unlike IBM, claim 1 of the present application is not directed to XSL conversion *per se*, as this is a well known technique that has also been disclosed in the Background section of the applicant's specification (see, for example, page 2, lines 15-17).

With regards to the specific limitations of claim 1, step (a) requires "determining if the message is to be sent to a topic subscriber;" The Examiner alleges that page 1, lines 1-9 of IBM discloses a message transmitted to a recipient over a network. The applicant respectfully disagrees. The cited section of IBM does not show any determination taking place. It merely discusses properties of a Text Transformation Engine. None of the recited Text Transformation Engine features relates to determining whether a message should be sent.

Furthermore, the determination in step (a) relates to whether the message is to be sent to a topic subscriber. As was pointed out by the applicant in the previous amendment and during the interview with the Examiner on December 20, 2004, a topic subscriber is not merely a "message recipient," as interpreted by the Examiner in the first Office Action. Rather, a topic subscriber

receives messages by subscribing to a queue or topic in an MOM (Message Oriented Middleware) system, such as a Java Message Service (JMS). The term topic subscriber has been explained in the application which states "a publisher will publish an XML message to a Queue or Topic in the MOM system. A subscriber may subscribe to the Queue or Topic and receive the XML message." (page 2, lines 2-4). It is respectfully submitted that IBM does not disclose a topic subscriber.

Step (b) recites "determining if the message is an extensible markup language (XML) message that conforms to an XML schema specified by a selected XSLT filter;" The Examiner alleges that the fact that IBM discloses applying an XSL template to an XML document anticipates this step. The applicant respectfully disagrees. Again, IBM does not disclose a two-step determination as to whether the message is an XML message and conforms to an XML schema specified by a selected XSLT (XSL Transformation) filter. IBM merely discloses applying an XSL template, which is not recited in step (b). Specifying and applying XSLT are well known operations in the prior art, and have also been discussed by the applicant in the Background section of the application, on page 2, lines 9-15. Determining whether a message conforms to an XML schema specified by a selected XSLT filter, however, is different. The applicant also wishes to point out that, as specified by the preamble, these operations occur on the service side in a distributed network, which is not discussed or mentioned in the IBM document.

Next, step (d) of claim 1 recites "sending the modified XML message to the topic subscriber" According to the Examiner, this step was allegedly anticipated by the same section of IBM that was used in rejecting step (a). Again, it should be noted that this section of IBM merely discloses general properties of a Text Transformation Engine. IBM does not mention any sending, it does not mention a modified XML message, and does not mention a topic subscriber.

As noted in the previous response and in the application, the service side filtering relates to several advantages that cannot be accomplished by conventional techniques. For example, the filtering makes it possible to transmit only selected portions of the XML message "over the wire," which preserves network bandwidth and improves latency (see, for example page 7, lines 5-10 of applicant's specification). For at least these reasons, the rejection of claim 1 is unsupported by the art and should be withdrawn.

Independent claims 5 and 9 relate to an apparatus and to a computer program product, respectively, and have limitations that are similar to the limitations of claim 1. Thus, for reasons substantially similar to those set forth above with respect to claim 1, the applicant respectfully

contends that the rejection under 35 U.S.C § 102(a) of independent claims 5 and 9 is unsupported by the cited art and should be withdrawn.

Claims 3-4, 7-8, and 11-12 all depend from independent claims 1, 5, and 9, respectively, and the rejection of these claims should be withdrawn for at least the reasons discussed above.

Claim Rejections – 35 U.S.C. § 103

Claims 2, 6 and 10 were rejected under 35 U.S.C § 103(a) as being unpatentable over IBM in view of Laitinen "XML Messaging," Tik-11.590 (hereinafter "Laitinen"). The applicant respectfully traverses these rejections.

Claim 2, depends from claim 1, and is neither anticipated nor obvious for at least the reasons discussed above with respect to claim 1. Claim 2 recites that the "determining (a) is performed by a JMS provider." The Examiner acknowledges that this is not shown by IBM, and relies on Laitinen to cure this deficiency. It is noted that Laitinen teaches that XML and Java messaging provide flexible and scalable communication in enterprise application integration.

In order to establish a *prima facie* case of obviousness, the Examiner must show a motivation to combine IBM and Laitinen. Even though the use of JMS to exchange XML documents is well known in the art, there is nothing in IBM or Laitinen that suggests a desire to combine the parameterized XSL style sheets of IBM with the flexible and scalable enterprise application integration system of Laitinen, in order to accomplish service side filtering of XML messages, as claimed by the applicant. Furthermore, the Examiner needs to show a reasonable expectation of success, which the Examiner has failed to do since he has not shown how IBM and Laitinen would be combined in order to achieve the service side filtering and the operations disclosed in claim 2. Finally, the combination of the references must teach or suggest all the claim limitations. Even if it were possible to combine IBM and Laitinen, the combination still would not teach the limitations of "determining if the message is to be sent to a topic subscriber;" "determining if the message is an extensible markup language (XML) message that conforms to an XML schema specified by a selected XSLT filter;" and "sending the modified XML message to the topic subscriber," as Laitinen does not show how to cure the deficiencies of IBM for these limitations, as discussed above.

For at least these reasons, the rejection of claim 2 is unsupported by the art and should be withdrawn. For reasons substantially similar to those set forth above, the applicant respectfully contends that the rejection of claims 6 and 10 is unsupported by the cited art and should be withdrawn.

Conclusion

The applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,
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